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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,136	10/23/2000	Herbert M. Straub	20003	9008

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/694,136

Applicant(s)

STRAUB ET AL

Examiner

Lawrence D Ferguson

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed February 21, 2003.

Claims 1-20 were amended and are pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suess et al. (U.S. 5,985,078) in view of Abrams (U.S. 5,908,527).

4. Suess discloses a metallic embossing foil (abstract) with carrier material that transfers colored layers on a surface (column 3, lines 42-44) conventionally used to wrap articles. Suess discloses a transparent layer applied to the colored layer applied by means of transfer foils which comprise a carrier film which are releasably disposed thereon to a hot embossing foil (column 3, lines 62-67). The reference discloses rolling a molded foil (column 4, lines 33-35) where the colored layer gives the foil a decorative pattern (column 4, lines 56-58 and column 7, lines 14-16). Suess discloses an adhesive

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layer on the foil (column 5, line 1). Suess does not disclose that the foil is used in foil wrapping of a substrate or as picture frame element or building trim piece ^{-take out}.

These features are directed to intended use of the claimed invention, which is given little patentable weight. Suess does not disclose the foil being laminated. Additionally the foil of Suess is used to wrap articles. Picture frame elements and building trim pieces are articles and so are included by the reference.

Abrams teaches a printed foil laminate (abstract and column 2, lines 12-15).

Suess and Abrams are analogous art because they are from the same field of foils. It would have been obvious to one of ordinary skill in the art to laminate the embossed foil of Suess because Abrams teaches laminated foils maintain composure better during the rolling process.

Claim Rejections – 35 USC § 103(a)

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams (U.S. 5,653,844) in view of Nelson (U.S. 4,724,026).

6. Abrams discloses a foil laminate with transfer printing (abstract) with impressions in the laminate (column 2, lines 4-5) leaving a decorative pattern with a suitable adhesive. Abrams discloses the molded foil laminate suitable to roll (column 2, lines 51-58 and column 4, lines 56-57) suitable to cover various packaging articles (column 7, lines 8-9). Abrams discloses a dry bond adhesive layer with an opaque colored material (column 7, lines 27-44). Abrams does not disclose that the foil is used in foil

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wrapping of a substrate or as picture frame element or building trim piece. These features are directed to intended use of the claimed invention, which is given little patentable weight. Additionally the foil of Abrams is used to wrap articles. Picture frame elements and building trim pieces are articles and so are included by the reference.

Abrams does not disclose carrier stripped from the foil or clear and opaque properties.

Nelson teaches a metallic foil with a transfer sheet stripped away leaving a decorated sheet on the foil (column 2, lines 40-50) along with a clear or colored coating, a release coat and a carrier film (column 3, lines 39-42) on the foil. Abrams and Nelson are analogous art because they are from the same field of foils. It would have been obvious to one of ordinary skill in the art to include the carrier and release layers with clear or colored coatings in the foil laminate of Abrams because Nelson teaches these layers improve the decorative properties of the film rendering the foil more marketable.

Claim Rejections – 35 USC § 103(a)

7. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weder (U.S. 6,324,813) in view of Nelson (U.S. 4,724,026).

8. Weder discloses a decorative wrapping cover (column 1, lines 21-30) embossed and having an ink lacquer applied (column 4, lines 55-67) where the sheet is a film, which is lacquered, embossed and printed on (column 10, lines 31-50) forming a pattern. Weder discloses the decorative cover formed using a conventional mold

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system (column 11, lines 63-67) where the sheet can be provided as a roll of material (column 6, lines 40-43). Weder does not disclose carrier stripped from the foil or clear and opaque properties.

Nelson teaches a decorative article with a transfer sheet stripped away leaving a decorated sheet on the foil (column 2, lines 40-50) along with a clear or colored coating, a release coat and a carrier film (column 3, lines 39-42) on the foil. Abrams and Nelson are analogous art because they are from the same field of decorative sheets. It would have been obvious to one of ordinary skill in the art to include the carrier and release layers with clear or colored coatings in the film laminate of Weder because Nelson teaches these layers improve the decorative properties of the film rendering the foil more marketable.

Response to Arguments

9. Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Suess et al. (U.S. 5,985,078) in view of Abrams (U.S. 5,908,527) have been considered but are unpersuasive. Applicant argues the rejection made is based upon 'metallic embossing foil' and Applicant's do not claim a 'metallic embossing foil' in any of the independent claims 1, 11 or 20 but refer to the term 'metallic' in claims 16 and 19. Because Applicant claims a metallic foil in the claims, it is proper that the rejection read on a metallic foil, in order to meet Applicant's claim limitation. Applicant's argument lacks merit because Suess in view of Abrams reads on a decorative molded printed material

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conventionally used to wrap articles. Additionally, as originally disclosed in the instant specification (pages 5-8) and claim language (claims 1-20), decorative molding wrapping foils and decorative molding wrapping films are analogous. Applicant argues Sues describes a normal transfer operation. Examiner would like to direct Applicant's attention to column 3, lines 62-67 of Sues, disclosing a layer applied to a color layer by means of transfer foils which comprise a carrier film and are releasably disposed thereon to a hot embossing foil. Applicant presents figures to show the references do not teach Applicant's disclosure. Regardless of the argument, Sues in fact discloses a decorative film (column 4, lines 56-58) comprising a hot transfer foil which comprise a carrier film releasably disposed thereon to a hot embossing foil, where the molded foil is rolled (column 4, lines 33-35). Applicant states the instantly claimed invention begins with a wrapping film (paper), applied to an adhesive to one side of the paper. In response to applicant's argument that the references fail to show certain features of applicant's invention, [✗] it is noted that the features upon which applicant relies (i.e., wrapping paper) is not recited in the rejected claim(s) [✗]. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues it is not the commercially available hot transfer material that Applicants seek to obtain a letters patent upon but rather the laminated wrapping material made by marrying at least two decorative materials together as shown. Examiner is not persuaded by this argument because the features upon which applicant relies (i.e., marrying at least two decorative materials) is not recited in the rejected claim(s).

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Applicant argues Abrams and Suess are different from each other and the instantly claimed invention. Examiner is not persuaded because Suess discloses a metallic embossing foil (abstract) with carrier material that transfers colored layers on a surface (column 3, lines 42-44) conventionally used to wrap articles. Suess discloses a transparent layer applied to the colored layer applied by means of transfer foils which comprise a carrier film which are releasably disposed thereon to a hot embossing foil (column 3, lines 62-67). The reference discloses rolling a molded foil (column 4, lines 33-35) where the colored layer gives the foil a decorative pattern (column 4, lines 56-58 and column 7, lines 14-16). Suess discloses an adhesive layer on the foil (column 5, line 1). Additionally, Abrams teaches a printed foil laminate (abstract and column 2, lines 12-15). Suess and Abrams are analogous art because they are from the same field of foils. It would have been obvious to one of ordinary skill in the art to laminate the embossed foil of Suess because Abrams teaches laminated foils maintain composure better during the rolling process.

Applicant's arguments of rejection under 35 USC 103(a) as unpatentable over Abrams (U.S. 5,653,844) in view of Nelson (U.S. 4,724,026) have been considered but are unpersuasive. Applicant provides drawing for the purpose of establishing visual reference for Abrams in view of Nelson. Applicant argues the combination does not teach the instant disclosure because the Figures drawn up by Applicant do not coincide with the instantly cited figures. Examiner disagrees because Abrams discloses a foil laminate with transfer printing (abstract) with impressions in the laminate (column 2, lines 4-5) leaving a decorative pattern with a suitable adhesive. Abrams discloses the

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molded foil laminate suitable to roll (column 2, lines 51-58 and column 4, lines 56-57) suitable to cover various packaging articles (column 7, lines 8-9). Abrams discloses a dry bond adhesive layer with an opaque colored material (column 7, lines 27-44). Abrams does not disclose that the foil is used in foil wrapping of a substrate or as picture frame element or building trim piece. These features are directed to intended use of the claimed invention, which is given little patentable weight. Additionally the foil of Abrams is used to wrap articles. Picture frame elements and building trim pieces are articles and so are included by the reference. Abrams does not disclose carrier stripped from the foil or clear and opaque properties.

Nelson teaches a metallic foil with a transfer sheet stripped away leaving a decorated sheet on the foil (column 2, lines 40-50) along with a clear or colored coating, a release coat and a carrier film (column 3, lines 39-42) on the foil. Abrams and Nelson are analogous art because they are from the same field of foils. It would have been obvious to one of ordinary skill in the art to include the carrier and release layers with clear or colored coatings in the foil laminate of Abrams because Nelson teaches these layers improve the decorative properties of the film rendering the foil more marketable.

Applicant argues Suess merely mentions embossing, which in turn comprises various meanings. Applicant claims an embossed laminated wrapping film, which is disclosed by the cited art, being that as originally disclosed in the instant specification (pages 5-8) and claim language (claims 1-20), decorative molding wrapping foils and decorative molding wrapping films are analogous.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774



ELIZABETH MULVANEY
PRIMARY EXAMINER